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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,959	04/12/2004	Bernhard Geuppert	861840-999025	2358
51442 7590 02/01/2007 JONES DAY 222 East 41st Street New York, NY 10017-6702			EXAMINER KIM, PAUL D	
			ART UNIT	PAPER NUMBER
			3729	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/01/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/821,959

Applicant(s)

GEUPPERT ET AL.

Examiner

Paul D. Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 17-19, 21, 22, 24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16, 20 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/20/04, 12/5/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is a response to the restriction requirement filed on 11/13/2006.

Election/Restrictions

1. Applicant's election with traverse of Group I, Species B, claims 9-16, in the reply filed on 11/13/2006 is acknowledged. The traversal is on the ground(s) that the non-elect claims 17, 20, 21, 23 and 24 are readable on the elected species. Examiner traverses the argument. This is not found persuasive because the claims 17, 21 and 24 for Species C and Species F are drawn to measuring an optical property of the at least two substrates while the at least two substrates are mounted on the mounting frame using a measuring beam which passes through two optical surfaces of at least one substrate, since the elected species B for claim 9 is drawn to a single substrate mounted on the measuring frame. However, examiner agrees with applicant that the claims 20 and 23 are readable on the elected species.

The requirement is still deemed proper and is therefore **made FINAL**.

2. Claims 1-8, 17-19, 21, 22, 24 and 25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/13/2006.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: --A METHOD OF MANUFACTURING AN OPTICAL COMPONENT--.

Claim Objections

4. Claim 23 is objected to as being a substantial duplicate of claim 20. Claim 20 and claim 23 are essentially duplicates of one another or else are so close in content that they both cover the same thing, despite a slight difference in wording. It is improper to have two claims, which contain the same limitations, in the same application as one claim would be a substantial duplicate of the other claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 9-15, 20 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Oshino (EP 1338911 A2).

Oshino teaches a process of making an optical component comprising steps of: mounting a substrate (20) on a mounting frame (25) as shown in Fig. 2(a); measuring a shape of the optical surface of the substrate; and processing the optical surface as disclose in col. 15, the paragraph [0055], wherein the substrate is mounted on the mounting frame during the measuring and the processing the optical surface (see also paragraph [0032] to paragraph [0039] and paragraph [00472] to paragraph [0055]). Oshino also shows the optical system as shown in Fig. 1 (also see paragraph [0032] to [0034], as per claims 20 and 23).

As per claim 10 the substrate is permanently mounted on the mounting frame during the measuring and the processing the optical surface.

As per claim 11 the mounting frame comprises three contact portions (22) disposed at distances from each other as shown in Fig. 2(a) for providing a mounting contact.

As per claim 12 the mounting frame is mounted to at least one adjacent mounting frame (40) as shown in Fig. 5.

As per claim 13 Oshino also teaches that the error (equivalent with a difference) is removed while the substrate is mounted on the frame (see paragraph [0048]).

As per claim 14 the measuring of the shape of the substrate is performed while the substrate is disposed in an orientation with respect to a direction of gravity (such as

downward), which is substantially the same as the predetermined orientation as shown in Fig. 2(b).

As per claim 15 the process of the optical surface is performed by polishing.

7. Claims 9, 10, 13 -11 are rejected under 35 U.S.C. 102(b) as being anticipated by Le Saux et al. (US PAT. 5,581,347).

Le Saux et al. teach a process of making an optical component comprising steps of: mounting lens on a mounting apparatus as shown in step 50; measuring a shape of the optical surface of the substrate as shown in steps 53-56; and processing the optical surface as disclose as shown in step 57 as shown in Fig. 6, wherein the lens are mounted on the mounting apparatus during the measuring and the processing the optical surface (see also col. 8, line 55 to col. 14, lines 26). Le Saux et al. also show the optical system as shown in Figs. 3-5 (as per claims 20 and 23).

As per claim 10 the substrate is permanently mounted on the mounting frame during the measuring and the processing the optical surface.

As per claim 13 the processing process is performed based on the measurement.

Claim Rejections - 35 USC § 103

8. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Oshino or Le Saux et al. and in view of Malyak et al. (US PAT. 6,515,750).

Either Oshino or Le Saux et al. teaches all of the limitations, but fail to disclose how the measuring process is preformed. Malyak et al. teach an interferometric system

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for an optical component in order to allow measuring semi-transparent optical objects (see also col. 6, lines 36-41). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify a process of measuring the surface of the optical component of either Oshino or Le Saux et al. by using an interferometric system as taught by Malyak et al. in order to allow measuring semi-transparent optical objects.

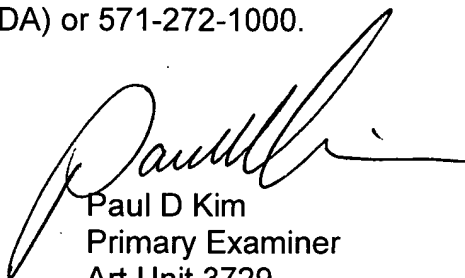
Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D. Kim whose telephone number is 571-272-4565. The examiner can normally be reached on Monday-Thursday between 6:00 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Paul D Kim
Primary Examiner
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